

Application Number 10/693,007
Response dated December 27, 2006
Responsive to Office Action mailed October 27, 2006

RECEIVED
CENTRAL FAX CENTER

DEC 27 2006

REMARKS

Applicant has not amended or added any claims. Claims 1-11 and 13-22 have been withdrawn pursuant to a Requirement for Restriction, claims 12 and 36 were previously canceled, and claims 23-35 and 37-45 are pending.

Claim Rejection Under 35 U.S.C. §§ 102(e) and 103(a)

In the Final Office Action, claims 23-28, 30, 34, 35, and 38-45 were rejected under 35 U.S.C. § 102(e) as being anticipated by Woods et al. (U.S. Patent Application Publication No. 2003/0114899). Claims 29 and 31-33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Woods et al., and claim 37 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Woods et al. in view of Greenberger et al. (U.S. Patent No. 5,355,369). Applicant respectfully traverses the rejections.

First, Applicant traverses the finality of the Office Action. According to M.P.E.P. § 706.07(a), "a second or any subsequent action on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an IDS filed during the period set forth in 37 C.F.R. 1.97(c) with a fee." The Office Action noted that "Applicant's submission of an [IDS] under 37 C.F.R. 1.97(c) with the fee . . . on 8/30/06 prompted the new ground(s) of rejection presented in this Office Action. Accordingly, this action is made final." However, Applicant notes that Woods et al. is a continuation-in-part of U.S. Patent No. 6,516,227, Meadows et al., which Applicant first cited in an IDS filed on June 30, 2004 (before the receipt of a first Office Action on the merits). The portions of Woods et al. relied on by the present Office Action, namely the disclosure of the RF module 650, microprocessor 620, display screen 240, hand held programmer 202, ROM port 647, and button pad 241 and FIG. 7A, were disclosed Meadows et al. Thus, Applicant submits that the new ground of rejection presented in the Office Action was not based on information submitted in an IDS filed during the period set forth in 37 C.F.R. 1.97(c) with a fee, but rather information submitted in IDS filed before a first Office Action on the merits, and the final status of the Office Action was improper. The Examiner had access to the prior art relied on in the present Office Action prior to the submission of the IDS on August 30, 2006, and the present rejection was not necessitated by the submission

Application Number 10/693,007
Response dated December 27, 2006
Responsive to Office Action mailed October 27, 2006

of the IDS filed on June 30, 2004. Accordingly, Applicant respectfully requests that the finality of the Office Action mailed on September 27, 2006 be withdrawn.

Applicant further traverses the rejection because the cited references fail to disclose each and every feature of the claimed invention and provide no teaching that would have suggested the desirability of modification to include such features.

For example, Woods et al. fails to teach each and every element of Applicant's independent claim 23. Claim 23 recites a first circuit board placed within a first housing member, a second circuit board placed over the first circuit board, and a second housing member placed over the second circuit board to substantially enclose the first and second circuit boards. Woods et al. does not teach or suggest this combination of elements. The Office Action interpreted Woods et al. as teaching a first circuit board (a RF module 650) placed within a first housing member (a microprocessor 620 or processor integrated circuit (IC)). It is unclear how the microprocessor in Woods et al. is a housing member. While Woods et al. mentions that the microprocessor or processor IC includes an RF module, Woods et al. does not even remotely suggest that the RF module is placed within a housing, which is the microprocessor. Furthermore, circuitry or a module within the microprocessor does not in any way constitute a "circuit board." As discussed in Applicant's Amendment in response to the Office Action filed on July 5, 2006, a circuit board supports and/or electrically connects electronic components. It is unclear how integrated circuitry fabricated by microlithography to form a microprocessor chip can be reasonably characterized as a circuit board. Consequently, Applicant is unable to ascertain how a microprocessor could possibly be construed as a housing, and how a functional module within such a microprocessor could possibly be construed as a circuit board.

Woods et al. also fails to teach or suggest a loading port accessible via a second housing member to load instructions into memory on one of the first and second circuit boards, as recited by claim 23. According to the Office Action, Woods et al. teaches a second circuit board (a display screen 240), a second housing member (a hand held programmer 202) placed over the display screen to substantially enclose the display screen and the RF module, a loading port (a ROM port 247) accessible via the second housing member, and a plate member (button pad 241) placed within the programmer to cover the ROM port. Applicant respectfully disagrees with this interpretation of Woods et al.

Application Number 10/693,007
Response dated December 27, 2006
Responsive to Office Action mailed October 27, 2006

Woods et al. describes the ROM port as being a part of the processor, which the Office Action alleged was the first housing member of the Woods et al. device. In particular, the ROM port is used to connect a serial EEPROM circuit to the processor. (Woods et al. at paragraph 205.) The ROM port in Woods et al. is not configured to be used to load instructions into memory on one of a first or second circuit board, i.e., the RF module or the display screen according to the Examiner's interpretation. Thus, the ROM port is not a "loading port . . . to load instructions into memory on one of the first and second circuit boards," as recited by Applicant's claim 23. Woods et al. does not even teach or suggest that the RF module or the display screen have a memory, so it is unclear how the ROM port would be used to load instructions into memory within the RF module or the display screen.

Furthermore, Woods et al. does not teach or suggest that the ROM port is accessible via the second housing, as required by claim 23. In fact, Woods et al. does not disclose how the ROM port is accessed, and thus cannot anticipate claim 23. FIGS. 7D-1 and 7D-2 of Woods et al., which are diagrams of the Woods et al. programming device from a circuit point of view, suggest that the ROM port is an internal component and is not externally accessible.

Woods et al. also fails to describe a plate member to cover the loading port, as recited by Applicant's claim 23. Even if the button pad in the Woods et al. device were construed as a plate member, which Applicant disputes, Woods et al. does not describe an arrangement in which the button pad covers the ROM port. The Office Action also failed to show how Woods et al. teaches this element of claim 23, and accordingly, does not meet its burden of showing anticipation of each and every element of independent claim 23.

As yet another example of the deficiencies in the Woods et al. reference is the failure to teach or suggest a "first housing member . . . wherein the first housing member, the first circuit board, the second circuit board, the second housing member and the plate member are assembled in a stacked z-axis configuration." Even if the microprocessor were somehow construed as a first housing member, the RF module as a first circuit board, the display screen as a second circuit board, and the programmer as the second housing member, Woods et al. in no way teaches or suggests that these elements are stacked in a z-axis configuration.

The Office Action reasoned that FIG. 7A of Woods et al. shows the "RF module 650, microprocessor 620, display screen 240, and button pad 241 . . . stacked." Applicant respectfully

Application Number 10/693,007
Response dated December 27, 2006
Responsive to Office Action mailed October 27, 2006

disagrees with this interpretation of FIG. 7A. FIG. 7A merely shows a plan view of the Woods et al. programmer, and does not even depict the internal components of the programmer. Thus, the arrangement between the RF module, microprocessor, display screen, and button pad is not clear by looking at FIG. 7A because FIG. 7A only shows the display screen and button pad. It does not necessarily follow that the RF module, microprocessor, display screen, and button pad are stacked in a z-axis configuration within the programmer shown in FIG. 7A merely because FIG. 7A illustrates a plan view of the programmer.

The fact that a certain characteristic may be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); MPEP 2112. The Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original); MPEP 2112. No reasonable support has been provided for the determination that the RF module, microprocessor, display screen, and button pad are stacked in a z-axis configuration. In fact, FIG. 7A supports the opposite conclusion because FIG. 7A depicts the button pad 241 and display screen 248 adjacent to each other, rather than stacked in a z-axis configuration.

In order to support an anticipation rejection under 35 U.S.C. § 102(e), it is well established that a prior art reference must disclose each and every element of a claim. This well known rule of law is commonly referred to as the "all-elements rule."¹ If a prior art reference fails to disclose any element of a claim, then rejection under 35 U.S.C. § 102(e) is improper.²

Woods et al. fails to disclose each and every limitation set forth in independent claim 23. Greenberger et al. fails to provide any teaching sufficient to overcome the basic deficiencies of Woods et al. For at least these reasons, the Examiner has failed to establish a prima facie case for anticipation under 35 U.S.C. § 102(e) of Applicant's independent claim 23, and claims 24-28, 30, 34, 35, and 38-45, which depend from claim 23, and a prima facie case for obviousness of

¹ See *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (CAFC 1986) ("it is axiomatic that for prior art to anticipate under 102 it has to meet every element of the claimed invention").

² *Id.* See also *Lewmar Marine, Inc. v. Barient, Inc.* 827 F.2d 744, 3 USPQ2d 1766 (CAFC 1987); *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (CAFC 1990); *C.R. Bard, Inc. v. MP Systems, Inc.*, 157 F.3d 1340, 48 USPQ2d 1225

Application Number 10/693,007
Response dated December 27, 2006
Responsive to Office Action mailed October 27, 2006

RECEIVED
CENTRAL FAX CENTER

DEC 27 2006

claims 29, 31-33, and 37 under 35 U.S.C. § 103(a). In view of the fundamental deficiencies evident in the cited references, it is not necessary to discuss in detail the additional patentable differences presented by the remaining dependent claims. In reserving comment, however, Applicant neither admits nor acquiesces in the Examiner's interpretation with respect to the teachings in such applied references or with respect to any features set forth in the dependent claims.

For at least these reasons, the Examiner has failed to establish a prima facie case for non-patentability of Applicant's claims 23-35 and 37-45 under 35 U.S.C. §§ 102(e) and 103(a). Withdrawal of this rejection is requested.

CONCLUSION

All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 50-1778. The Examiner is invited to telephone the below-signed attorney to discuss this application.

Date:

By:

December 27, 2006
SHUMAKER & SIEFFERT, P.A.
8425 Seasons Parkway, Suite 105
St. Paul, Minnesota 55125
Telephone: 651.735.1100
Facsimile: 651.735.1102

Jessica H. Kwak
Name: Jessica H. Kwak
Reg. No.: 58,975

(CAFC 1998); *Oney v. Ratliff*, 182 F.3d 893, 51 USPQ2d 1697 (CAFC 1999); *Apple Computer, Inc. v. Articulate Systems, Inc.*, 234 F.3d 14, 57 USPQ2d 1057 (CAFC 2000).